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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,645	02/20/2004	Takahiro Goto	Q79923	2125
23373	7590	05/17/2006		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/781,645

**Applicant(s)**

GOTO, TAKAHIRO

**Examiner**

Barbara L. Gilliam

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-6 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6 and 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/21/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 21, 2006 has been entered.

### ***Response to Amendment***

2. The amendment filed February 21, 2006 has been entered and fully considered.

The amendment does not raise any new matter issues as evidenced by the certified translation of paragraph [0086] of Japanese Patent Application No. 2003-44093 from which the present application claims priority and the original specification.

3. Claims 4-6, 10-17 and 18 are pending.

Claims 1-3, 7-8 and 9 were canceled by Applicant.

### ***Information Disclosure Statement***

4. The IDS submitted February 21, 2006 has been fully considered.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-6, 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (EP 1 223 196 A2) in view of Sugasaki et al. (US 2004/0072101 A1).

a. The applied reference (Sugasaki et al.) has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

b. Nakamura et al. teach a negative image-recording material, used to make a printing plate, wherein the negative image-recording material comprises a cyanine IR absorbent, a radical generator, a radically polymerizable compound and polymer binder (abstract; [0088]-[0096], claims 1 and 29). The IR absorbents of formula (3), (3-1), IR-

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1, IR-2, and IR-5 meet the present limitations for the presently claimed infrared absorbing compound. A sulfonium salt is among the preferred radical generators and is represented by general formula (V) (claims 15-20; [0066]-[0069]). In general formula (V), R<sub>31</sub>, R<sub>32</sub> and R<sub>33</sub> are optionally substituted hydrocarbon groups having at most 20 carbon atoms. Examples of substituents include halogen atoms. Nakamura et al. do not exemplify a sulfonium salt having three aryl groups two of which are substituted specifically with chlorine atoms however it would have been obvious to one of ordinary skill in the art to incorporated any halogen substituent including chlorine atoms. Other preferred radical generators include iodonium salts and diazonium salts, which can be used alone or in combination of two or more (claims 15-20; [0066]-[0072]). Linear organic polymers, soluble or swellable in water or weakly alkaline water, are preferred as the binder polymer ([0088]). Nakamura et al. does not teach the binder polymer required in the present application. However, based on the teachings of Sugasaki et al. it would have been obvious to one of ordinary skill in the art to use the binder polymer having a repeating unit of formula (I) wherein R<sup>2</sup> represents a linking group having 2 to 82 atoms such as alkylene, and substituted alkylene in order to control the developing velocity and permeating velocity of the developer (abstract; [0019]; [0037]). According to Nakamura et al., especially preferred supports of the image forming material are aluminum supports having a center line average roughness between 0.1 and 1.2  $\mu\text{m}$  ([0116]-[0127]).

***Response to Arguments***

7. Claims 4-6 were inadvertently left out of the body of the Office Action however said claims were rejected as indicated on the Office Action Summary, specifically under 35 USC 103(a) over the combination of Nakamura in view of Oshima along with claims 7-18.

8. Applicant's arguments filed February 21, 2006 have been fully considered but they are not persuasive.

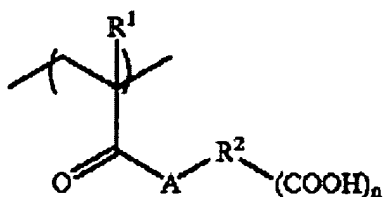
a. Applicant argued the cited references (Nakamura and Oshima) do not teach the presently claimed invention. In light of the amendment, Oshima is replaced with Sugasaki. In Sugasaki, the binder polymer, having a repeating unit of formula (I) wherein  $R^2$  represents a linking group having 2 to 82 atoms such as alkylene, and substituted alkylene, meets the present limitations for the binder polymer.

b. Applicant argued unexpected superior results and submitted a Declaration under 37 CFR 1.132 as support thereof. However Applicant's findings are not commensurate in scope with the claims. "Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the 'objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.' In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range." *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). MPEP 716.02 (d). Independent claim 4 requires that at least two of the aryl groups of the sulfonium salt polymerization initiator are substituted. However the sulfonium salt polymerization initiator used in

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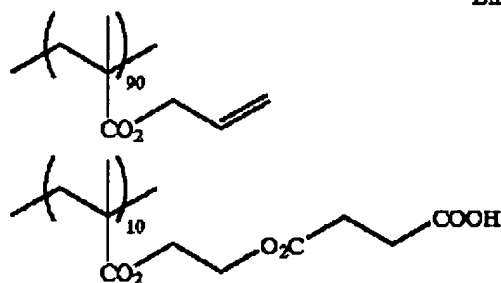
the comparative examples comprises three aryl groups none of which are substituted with a chlorine atom while the sulfonium salt polymerization initiator used in the inventive example comprises three aryl groups all of which are substituted with a chlorine atom. Therefore it is not clear if the same superior results are attainable when a sulfonium salt polymerization initiator comprising three aryl groups, two of which are substituted with chlorine atoms is used. Secondly it is not clear if the superior results are attainable over samples wherein only one aryl group is substituted with a chlorine atom.

Additionally, in independent claim 1, the binder polymer has the structure



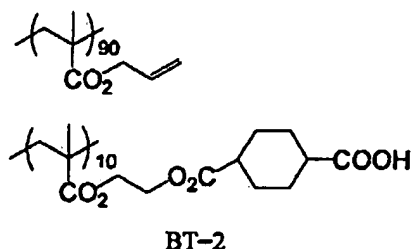
wherein the  $R^2$  groups represents a linking group having a chain structure composed of 2 to 82 atoms and A can be an oxygen atom or  $NR^3$  ( $R^3$  represents a hydrogen atom, an oxygen atom, a nitrogen atom and a sulfur atom) and n can be 1 to 5. The binder polymer used in inventive examples is BT-1 has the following structure:

Binder polymer (BT-1)



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while the binder polymer of the comparative examples is BT-2 has the following structure:



Applicant has only shown “superior results” which respect to one specific compound when countless other compounds would satisfy the claimed criteria. For these reasons, the Examiner finds the argument to be unpersuasive.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
May 10, 2006